

Applicants: Watson et al.
Serial No.: 10/826,785
Filing Date: April 16, 2004
Docket No.: ZIL-308-1C

REMARKS

Reconsideration and allowance are respectfully requested.

Before entry of this Response, claims 1-9 and 18-29 were pending. In the present Response, claim 4 is amended. After entry of the Response, claims 1-9 and 18-29 are pending.

I. Claims 1-9 and 18-29

Claims 1-9 and 18-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura (US Patent No. 6,211,797) in view of Nykanen (US Patent No. 6,728,774) (Office Action, p. 2, lines 10-11). To establish a *prima facie* case of obviousness, the Examiner must demonstrate three criteria. The MPEP § 2142 states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claimed limitations.” MPEP § 2142 (emphasis added).

The combination of Kimura and Nykanen does not form the basis for a valid rejection under § 103(a) for two reasons. First, the references when combined do not teach or suggest all of the claim elements. Second, there is no suggestion or motivation in either Kimura or Nykanen to combine the teaching of one with the teachings of the other.

A. Independent claims 1, 5, 18 and 26

Each of independent claims 1, 5, 18 and 26 recites an application in addition to a protocol stack. Claims 1 and 5 each recite, “wherein the

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communication contains instructions from an application set in the peripheral device" (emphasis added). Claims 18 and 26 recite, "wherein the second device contains an application having a configuration" (emphasis added). In one embodiment, the second device is a printer, and the application is a software program for executing a function of printing on the second device.

The Examiner acknowledges "that Kimura does not disclose that the communication contains instructions from an application set in the peripheral device" (Office Action, p. 3, lines 8-10). The Examiner states, however, that Nykanen teaches at column 4, lines 2-19, the discovery of an application set in other devices. Applicants respectfully disagree.

Kimura and Nykanen do not form the basis for a valid rejection of claims 1, 5, 18 and 26 under § 103(a) because neither Kimura nor Nykanen teaches or suggests all of the claim elements. Specifically, neither Kimura nor Nykanen teaches instructions from an application set in a peripheral device.

The passage of Nykanen cited by the Examiner does not concern an application as recited by claims 1, 5, 18 and 26. The "application" recited in claims 1, 5, 18 and 26 is not used to establish a communication connection. Instead, instructions of the application are communicated between the device and the peripheral device once wireless communications have been established. The passage of Nykanen, however, does not teach software programs for executing functions on a peripheral device, such as printing. Instead, the "discovery process" taught in Nykanen is the process of discovering which peripheral devices can be communicated with. Nykanen teaches neither the discovery of which applications are running on those devices, nor the discovery of which application sets run those applications.

Second, the Examiner points to no suggestion or motivation in Kimura to combine the teachings of Kimura with the teachings of Nykanen. There is no suggestion in either Kimura or Nykanen to extend the inquiry as to the appropriate infrared scheme for communicating between a device and a

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peripheral device into an inquiry as to the appropriate version of software programs for executing functions on the peripheral device.

Because the combination of Kimura and Nykanen does not disclose all of the elements of claims 1, 5, 18 and 26, and furthermore because there is no suggestion or motivation to combine Kimura and Nykanen, Kimura and Nykanen do not form the basis for a valid rejection under § 103(a). Reconsideration of the § 103(a) rejection and allowance of claims 1, 5, 18 and 26 are requested.

B. Dependent claims 2-4

Claims 2-4 depend from claim 1 and are allowable for at least the same reasons for which claim 1 is allowable. Allowance of claims 2-4 is requested.

C. Dependent claims 6-9

Claims 6-9 depend from claim 5 and are allowable for at least the same reasons for which claim 5 is allowable. Allowance of claims 6-9 is requested.

D. Dependent claims 19-25

Claims 19-25 depend from claim 18 and are allowable for at least the same reasons for which claim 18 is allowable. Allowance of claims 19-25 is requested.

E. Dependent claims 27-29

Claims 27-29 depend from claim 26 and are allowable for at least the same reasons for which claim 26 is allowable. Allowance of claims 27-29 is requested.

II. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the entire application (claims 1-9 and 18-29) is in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. The

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undersigned can be contacted at (925) 621-2121 to discuss any aspect of this application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By 
Darien K. Wallace

Date of Deposit: April 6, 2006

Respectfully submitted,



Darien K. Wallace
Attorney for Applicants
Reg. No. 53,736
Customer No. 47,713